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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/579,593	05/17/2006	Edgar Von Gellhorn	041281.00010	3553
26712	7590	06/23/2009		
HODGSON RUSS LLP THE GUARANTY BUILDING 140 PEARL STREET SUITE 100 BUFFALO, NY 14202-4040			EXAMINER TUROCY, DAVID P	
			ART UNIT 1792	PAPER NUMBER
			MAIL DATE 06/23/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/579,593	VON GELLHORN ET AL.	
	Examiner	Art Unit	
	DAVID TUROCY	1792	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/16/06</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Objections

1. Claims 8, 13, and 14 objected to because of the following informalities: Claims include "has/have been" language which should more reasonable be "is/are".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 10 provides for the use of an outer layer, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claim 10 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, and 10 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5565049, by Simmons et al.

Simmons discloses a PTFE coated conveyer belt, which inherently has an inner and outer coating as required by the claim (Column 4). The references uses the outer layer as required by claim 10. While the prior art does not disclose plasma, the claims are directed to the product and the applicant has not provided any factual evidence that the claims product is materially different then the prior art product.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3-4 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons as applied to claim 1-2 above.

Simmons fails to explicitly disclose the PTFE thickness, however, determination of a film thickness is well within the skill of one of ordinary skill in the art and Simmons discloses the coating is applied for a specific reason, as a release coating, and therefore it would have been obvious to a person having ordinary skill in the art at the

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time the invention was made to determine the appropriate and optimum PTFE thickness, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

8. Claims 1-5, 7-11, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons as applied to claim 1-2 above in view of US Patent 5744241 by Hobson et al. , US Patent 5244730 by Nguyen et al., and US Patent 4767641 by Kieser et al.

Claims 1 and 5: Simmons discloses a PTFE release coating on the surface of a conveyor belt as discussed above, but fails to explicitly disclose a plasma process. However, Hobson discloses PTFE release coatings are known in the art to be deposited by plasma process (column 3, lines 40-45), Nguyen discloses known and suitable plasma conditions for PTFE film formation, and Kieser discloses plasma can be used to deposit films on various substrates. Therefore, taking the references' collectively it would have been obvious to one of ordinary skill in the art to have modified Simmons to deposit the PTFE coating with a plasma process with a reasonable expectation of successful and predictable results because Hobson discloses PTFE is deposited by plasma process, Nguyen discloses known plasma processes for depositing the PTFE and Kieser discloses various substrate can be plasma coated.

Claims 2-4, 11: The process will inherently include an under layer and an outer layer (i.e. can not form a layer without first an under layer and thereafter an outer layer, the natural progression of deposition of films.) The references fails to explicitly disclose

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the PTFE thickness, however, determination of a film thickness is well within the skill of one of ordinary skill in the art and Simmons discloses the coating is applied for a specific reason, as a release coating, and therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to determine the appropriate and optimum PTFE thickness, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 7: Nguyen discloses 13.56 MHz as the plasma power (Column 3, lines 60-62).

Claim 8-9, 14: Nguyen discloses C₂F₄.

Claim 10: Simmons discloses use as claimed.

9. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Simmons as applied to claim 1-2 above in view of US Patent 5744241 by Hobson et al. and US Patent 5888591 by Gleason et al.

Claims 1 and 5: Simmons discloses a PTFE release coating on the surface of a conveyor belt as discussed above, but fails to explicitly disclose a plasma process. However, Hobson discloses PTFE release coatings are known in the art to be deposited by plasma process (column 3, lines 40-45) and Gleason discloses a method for deposition of a PTFE coating on the surface of a substrate that provides increased flexibility (Column 3) and discloses pulsing power to form multiple layers with an increase in film properties (figures for examples). Therefore, taking the references'

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collectively it would have been obvious to one of ordinary skill in the art to have modified Simmons to deposit the PTFE coating with a plasma process with a reasonable expectation of successful and predictable results because Hobson discloses PTFE is deposited by plasma process Gleason discloses known plasma processes for depositing the PTFE onto any number of substrates to reap the benefit of increased film flexibility and properties

Claims 2-4, 11: The process will inherently include an under layer and an outer layer (i.e. can not form a layer without first an under layer and thereafter an outer layer, the natural progression of deposition of films.) The references fails to explicitly disclose the PTFE thickness, however, determination of a film thickness is well within the skill of one of ordinary skill in the art and Simmons discloses the coating is applied for a specific reason, as a release coating, and therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to determine the appropriate and optimum PTFE thickness, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Claim 6: The pulsing results in different plasmas as required by the claim.

Claims 7 and 12: Gleason discloses 13.56 MHz as the plasma power (column 11, lines 50-55).

Claim 8-9 and 13-14: Nguyen discloses C₂F₄,

Claim 10: Simmons discloses use as claimed.

Information Disclosure Statement

10. The information disclosure statement filed 6/16/2006 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each reference listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered. The crossed out references on the PTO-1449 are in a foreign language and there is no concise statement as to the relevance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID TUROCY whose telephone number is (571)272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/David Turocy/
Examiner, Art Unit 1792